

REMARKS

Favorable reconsideration and allowance of the present patent application are respectfully requested in view of the following remarks. Claims 1-11 were pending. Claims 1 and 2 have been amended. No claims have been added or cancelled by this Reply. Claims 1, 2 and 10 are independent.

While claims 1 and 2 are amended, Applicants do not concede that the Office Action's statutory rejections are proper. The amendments are understood to not narrow the scope of the claimed embodiments nor have they been made for reasons related to patentability. Rather, the amendments are made to clarify the claimed embodiments. Thus, in future construction or interpretation, the amended claims should be entitled to a full range of equivalents.

Rejection under 35 U.S.C. §103(a) based on Nagel et al, Kasajima et al. and Spira et al

Claims 1-3, 6, 7, 10, and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nagel et al. (U.S. Patent No. 5,592,549) in view of Kasajima et al. (U.S. Publication No. 2002/0007304), and claims 4, 5, 8 and 9 stand rejected under 35 U.S.C.

103(a) as being unpatentable over Nagel et al. in view of Kasajima et al. as applied to 1 and 2 above, and further in view of Spira et al. Applicant respectfully traverses these rejections.

Regarding the applied rejection against independent claims 1, 2 and 10, Applicant respectfully submits that the Examiner failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion of motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference must teach or suggest all the claim limitations, see *In re Vaeck*, 947 F.2d 48, 20 USPQ2d 1438 (Fed.Cir.1991).

In the Office Action, it is asserted that the combination of Nagel et al. and Kasajima et al. discloses all recited elements of independent claims 1, 2, and 10. However, this assertion is incorrect.

For example, Nagel et al. discloses a method and apparatus for retrieving selected information from a secure information source. More specifically, the system according to one preferred embodiment

involves a digital computer workstation which is capable of retrieving secure information stored on one or more CD-ROMs. The focus of the patent involves individual items of information "information packets" which are encrypted prior to storage on a CD-ROM. Only an authorized user with the proper validated code and sufficient credit is allowed to decrypt the encrypted information packets. The system includes a personal computer 10, a CD-ROM reader 12 and a decryption controller 14. The decryption controller 14 keeps a running account of the identify of the brand code assigned to and the charge for each information packet that is decrypted. In the preferred embodiment, the decryption controller 14 is disposed in its own enclosure separate and apart from the personal computer 10 and also the CD-ROM reader 12. The system of Nagel et al. is specifically directed to a secure information source in order to discourage and inhibit unauthorized storage and retrieval of unsecured information which has been electronically retrieved by an authorized user.

Except for bits and pieces of the claimed invention, nothing in Nagel et al. suggests a method for servicing and maintaining thermal equipment, water treatment equipment and the like performed between at least one facility site that has equipment and conclude

a servicing and maintenance contract regarding the equipment, as set forth in the preamble of claim 1 and claim 2.

Also, as noted by the Examiner, Nagel et al. fails to teach the step of monitoring the equipment to collect operating state information regarding the equipment. This step is recited in independent method claims 1 and 10. Independent claim 2 recites a part of this step where the facility site has an information retrieval unit that is capable of monitoring the equipment to collect operating state information regarding the equipment. Additionally, the Examiner indicates that Nagel et al. fails to teach the step of detecting an abnormality in the operating state of equipment, which is recited in independent claim 10. Accordingly, Nagel et al is not even analogous art and fails to teach or suggest specific features of the claimed invention.

Surely, the Examiner is well aware that the cited reference must be considered in its entirety including disclosures that teach away from the claimed invention. See *M.P.E.P.* 2142.02. If the proposed modification renders the cited reference unsatisfactory for its intended purpose, then by definition, there is no suggestion or motivation to make the proposed modification. See *M.P.E.P.* 2143.01. Thus, if the proposed modification renders the cited

reference unsatisfactory for its intended purpose, the rejection must fail.

Kasajima et al. discloses a service server 6 that receives specific individual information D2 from a house, analyzes the information and searches for the most appropriate advertisement. The server introduces information corresponding to goods or services to be recommended for purchase or maintenance to the living facilities and equipment. The information is then distributed to the house through a communication terminal 1. Accordingly, the system provides advertisement and introduction information which is timely displayed at the dwelling house every time attribute information for the living facilities and equipment are changed so that direct marketing can be effectively achieved.

In the Office Action, it is merely stated that it would have been obvious to modify the Nagel et al. invention in accordance with the teachings of Kasajima et al. simply "for purpose of providing a system of preparing market trend investigation reports on new products or new service by collecting and sending storing daily use actual result of home appliances and electronic products or other related matter about customers to a center management server equipped on a communication network."

Even if these assertions were true, a *prima facie* case of obviousness has not been established, since the references provide no suggestion or motivation.

In this instance, it appears that the only motivation to combine has been gleaned from the teachings of the present application. This constitutes impermissible hindsight, however. See MPEP 2141. Simply put, there is no showing in the Office Action that the conclusion of obviousness was reached on the basis of facts gleaned from the prior art, and not from the claimed invention. See MPEP 2143.

Indeed, it appears that an obviousness has been assumed merely on the assumption that the combination of the references includes some of the claimed elements. However, it is well established that even if the combination of the references teaches every element of the claimed invention, without some motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. See MPEP 2143.01.

In this instance, Kasajima et al. is mainly directed toward selling and advertising in a direct marketing system. See paragraph #0078. The Examiner provides no reason why Nagel et al. needing a step of monitoring the equipment to collect operating

state information regarding the equipment, needing a step where the facility site has an information retrieval unit that is capable of monitoring the equipment to collect operating state information regarding the equipment, or needing a step of detecting an abnormality in the operating state of equipment, to meet the features of the claimed invention would look to Kasajima et al.

The Examiner purports a common sense and common knowledge reason for the deficiencies of Nagel et al, in other words, stating that Nagel et al would have suggested a similar technique. However, common sense and knowledge are not objective evidence of record, as the Federal Circuit explains, but are in fact commensurate with subjective belief and unknown authority. Therefore, the Examiner has failed to meet the legal requirements to substantiate the obviousness rejection.

Recent Federal Circuit case law precedent makes it explicitly clear that the factual question of motivation is material to patentability and cannot be resolved on subjective belief and unknown authority, but must be read on the objective evidence of the record. Federal Circuit case law precedent further requires that "common sense and common knowledge" alone is improper evidence in support of an obviousness rejection.

For an illuminating discussion on the burden placed on an Examiner to establish objective factual findings of record, the Examiner is referred to the recent Federal Circuit decision of *In re Lee*, 61 USPQ2d 1430 (CAFC 2002).

*In re Lee* involved an appeal of a decision of the Board of Patent Appeals in which *Lee* argued that the Examiner failed to provide a source of a teaching, suggestion, or motivation to combine the applied prior art to arrive at the claimed invention. The Board responded to these arguments by ruling that "[t]he conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *Id.* at 1432. The Federal Circuit overturned the Board's decision "for failure to meet the adjudicative standards for review under the administrative procedure act." *Id.* at 1431. The Federal Circuit further stated that "the factual inquiry whether to combine references must be thorough and searching...it must be based on objective evidence of record...[t]his precedent has been reinforced in a myriad of decisions and cannot be dispensed with." *Id.* at 1433. The Court also stated that the USPTO is "not free to refuse to follow Circuit precedent" and "cannot rely on conclusionary



statements when dealing with particular combinations of prior art and specific claims." *Id.* at 1434.

As stated herein above, the Examiner's asserted modification for Nagel et al which is to provide "a system of preparing market trend investigation reports on new products or new service by collecting and sending storing daily use actual result of home appliances and electronic products or other related matter about customers to a center management server equipped on a communication network." lacks factual support thereof and comports very closely to the analysis disapproved by the Federal Circuit in *In re Lee*. As such, the Examiner's failure to provide factual support for a teaching, suggestion or motivation to modify Nagel et al. constitutes legal error.

Therefore, the combination of Nagel et al. and Kasajima et al. is improper. Thus, independent claim 1 is distinguishable over Nagel et al. and Kasajima et al.

For similar reasons, independent claims 2 and 10 are also distinguishable over the combination of Nagel et al. and Kasajima et al.

Claims 3-9 and 11 depend directly or indirectly from independent claims 1, 2, and 10. Therefore, these dependent claims are also

distinguishable over the combination of Nagel et al. and Kasajima et al. for at least the reasons stated with respect to the independent claims.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance, and such allowance is earnestly solicited.

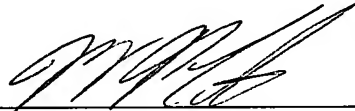
However, should there be any outstanding matters that may be resolved by a telephone conference, the Examiner is invited to contact Daniel K. Dorsey (Reg. No. 32,520) at 703-205-8000 in an effort to expedite prosecution.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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